

REMARKS***Election/Restrictions***

Claims 11 and 13-17 were previously withdrawn as being drawn to a non-elected invention but Applicants reserve the right to pursue the withdrawn claims in a divisional application.

Applicants submit that, for at least the following reasons, the rejections are overcome.

Claim Rejections - 35 U.S.C. 102

In the present Office Action, claims 1, 2 and 7 stand rejected under 35 U.S.C. 102(b) as being anticipated by Wallace (3,007,594) or MacDonald et al. (2,562,726). According to the Office Action, either Wallace or MacDonald et al. teach a container having a first thin-walled bottle with a neck extending from a storage portion, and a minimum wall thickness, and a molded over resin body having a maximum wall thickness at least three times the minimum wall thickness of the storage portion.

Claim 1 has been amended to indicate that the resin body is made from a thermoplastic molding resin injection over-molded at a temperature in the range of 160-180°C about the first bottle. Amended claim 1 is presented along with the other claims in the application in a separate document titled "AMENDED CLAIMS" submitted concurrently herewith.

Thermoplastic resins as claimed herein can be remelted and cooled numerous times without undergoing appreciable chemical change. Applicant's position is supported by the definition provided by the Examiner from TheFreeDictionary.com which states "thermoplastic materials can be remelted and cooled time after time without undergoing any appreciable chemical change".

In contrast, thermosetting resins undergo appreciable chemical change. Generally, once cured, thermosetting resins are permanently hardened and cannot be remelted and reshaped.

Wallace discloses positioning heat expansible plastic beads in a mold cavity and then subsequently expanding the beads by introducing steam into the cavity. Prior to placement in the mold cavity, the beads are partially expanded by the application of heat. After placement in the mold, steam is introduced to further expand the beads.

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While the plastic beads are twice subjected to expansion, there is no indication that the plastic used can be re-melted and cooled time after time without appreciable chemical change. In fact, Wallace teaches that the plastic beads contain volatile liquid as an expanding agent (col. 4, lines 65-75). Because there is no indication that the expansion process can be reversed, it is apparent that the plastic disclosed by Wallace is a thermoset plastic that undergoes appreciable chemical change. The plastic disclosed by Wallace is not a *thermoplastic* molding resin, and is not injected at a temperature in the range of 160-180°C. Thus, Wallace does not anticipate the present invention and cannot support a rejection under 35 U.S.C. 102(b).

MacDonald et al. disclose an urn cast over a glass liner *without the use of heat and pressure* (col. 5, lines 11-12). Accordingly, MacDonald does not disclose a resin body made from a thermoplastic molding resin, and does not disclose injection molding. Thus, MacDonald et al. fails to disclose all of the elements in the present claims as amended.

A rejection under 35 U.S.C. 102(b) requires that each element of a pending claim be disclosed in a single prior art reference. Because neither the Wallace nor MacDonald et al. references disclose each element of claims 1, 2 or 7, neither reference supports an anticipation rejection under 35 U.S.C. 102(b). Because the Examiner has failed to rebut each of the points raised above, the rejection of claims 1, 2 and 7 under 35 U.S.C. 102(b) as being anticipated by Wallace (3,007,594) or MacDonald et al. (2,562,726) must be withdrawn.

In the present Action, Claims 1, 2, 4, 5 and 7-9 stand rejected under 35 U.S.C. 102(b) as being anticipated by Barriere (3,663,259).

As noted above, claim 1 has been amended to indicate that the resin body is made from a thermoplastic molding resin injection over-molded at a temperature in the range of 160-180°C about the first bottle.

According to the Office Action, the limitation "a resin body... injection over-molded" does not impart any structure over the container of Barriere. The Examiner asserts that the final container is no different from the plastic in Barriere.

It is well known that injection molding does impart structural differences over cast resin bodies (e.g., different molecular level structure). The Examiner fails to dispute this structural distinction with substantive arguments or information. The Examiner merely declares that the final container is no different from the plastic in

Barriere. Applicants respectfully request that the Examiner support this conclusion with substantive arguments or information.

A rejection under 35 U.S.C. 102(b) requires that each element of a pending claim be disclosed in a single prior art reference. The Barriere reference fails to teach (or suggest) a resin body made from a thermoplastic molding resin and fails to teach (or suggest) a resin body injection over-molded at a temperature in the range of 160-180°C about a first bottle. At best the Barriere reference teaches coating by dipping or casting in a liquid polyester resin (the state of the art for polyester resins at the time of the Barriere invention). There is nothing in the Barriere reference that teaches a thermoplastic resin body injection overmolded on a thin-walled bottle.

Because Barriere does not teach a thermoplastic resin body injection over-molded at a temperature in the range of 160-180°C about a thin-walled bottle, Barriere does not teach each element of claim 1. The present invention as recited in claim 1 therefore distinguishes from and is patentable over the Barriere reference. Thus, with respect to claims 1, 2, 4, 5 and 7-9, the rejection under 35 U.S.C. 102(b) as being anticipated by Barriere (3,663,259) is traversed and must be withdrawn.

Claims 1, 2, 4, 5 and 7-9 stand rejected, in the alternative, under 35 U.S.C. 103(a) as being unpatentable over Barriere in view of Nohara or Wallace or Valyi.

According to the Office Action Wallace teaches that it is known to the outer resin body by injection molding.

Applicant disagrees. Wallace does not teach or suggest injection molding. Wallace teaches filling a mold with heat expansible plastic beads. This is not injection molding. Furthermore, the present claims recite a thermoplastic resin. Neither Barriere nor Wallace teach or suggest a thermoplastic resin, therefore, the combination of the teachings would not yield the present article as claimed. The Examiner failed to address each point above.

With respect to the combination of Barriere and Nohara, the Examiner has again failed to provide the motivation for such combination. Combining the teachings of two references requires at least a suggestion that would motivate one make the combination. This is generally understood to be at least a suggestion that the combined teachings of the two references would yield a benefit or an advantage. The Examiner did not assert such a benefit or advantage, and there is in fact no benefit or advantage taught or suggested in either reference that would motivate one to combine the teachings of the two references.

The two references in fact address different art areas. Barriere discloses coating a fully formed bottle. Nohara discloses injection over-molding to make a multilayer **pre-form** for the eventual production of a bottle by draw-blow forming. Thus, Nohara teaches injection over-molding of a pre-form of a bottle, not injection over-molding a resin body about a bottle. Since there is no suggestion in either reference that a benefit or advantage would be yielded by combining the references, there would be no motivation to combine these references. Because there would be no motivation to combine the references, the rejection of the claims based on the combination is not well taken and must be withdrawn.

In the unlikely event that one would be motivated to combine the teachings of the Barriere and Nohara references (as noted above, there would be no motivation to do so), combining the teachings would not yield the present invention as claimed. As noted, Barriere teaches coating a resin onto a bottle. Nohara teaches injection molding a resin outer layer *onto a resin pre-form*. The resulting multi-layer pre-form is subsequently draw-blow formed into a finished bottle. The Barriere reference coats a finished bottle, not a pre-form, and does not teach or suggest subsequent operations, such as draw-blow molding, to form a finished bottle because none are necessary. The coated bottle of Barriere is finished. The resulting products of the two operations are also radically different. The Barriere reference yields a finished glass bottle with a resin coating. The Nohara reference yields a multi-layer pre-form with a resin inner layer, a barrier layer and resin outer layer. There is no teaching or suggestion that this multi-layer pre-form or any of its individual layers would be suitable for use in coating a glass bottle. Thus, even if the teachings of Barriere were combined with the teachings of Nohara, one would not arrive at a resin coating on a finished bottle according to Barriere.

Similarly, the Examiner has failed to provide the motivation for combining the teachings of Valyi and Barriere. Valyi is a multi-part bottle with a separate bottom that is installed after the neck and side walls are finished. This is because the process disclosed by Valyi requires a core inserted through the open bottom of the container to prevent the sidewalls from collapsing during pressure molding. The core is essential to the process. It was certainly provided because, until recently, it was commonly thought that pressure molding over a container required a core to prevent the container from collapsing. Valyi uses the core to avoid collapsing the sidewalls. Barriere uses casting rather than pressure molding to avoid collapsing the container. There would be no

motivation to combine the references because there is no way to provide a core in the bottle shown in Barriere.

Because there would be no motivation to combine the Barriere and Nohara or Valyi references, and/or because even if the teachings of Barriere and Nohara or Valyi were combined one would not arrive at the present invention as claimed, the rejection of claims 1, 2, 4, 5 and 7-9 under 35 U.S.C. 103(a) as being unpatentable over Barriere in view of Nohara or Valyi is not well taken and must be withdrawn.

The Examiner fails to provide a reference or some other information that indicates that it is well known to inject thermoplastic resins over thin walled bottles. The Examiner merely states that "one of ordinary skill would recognize..."

Applicant respectfully disagrees. Articles of the type recited in the present claims have previously not been commercially available because those skilled in the art considered them unfeasible. It was believed that the high pressures and high temperatures involved would crush the thin walled bottle, particularly if the bottle was made of a brittle material like glass, or a malleable material like aluminum. For this reason, Barriere teaches casting or dipping the bottle, MacDonald teaches casting and Wallace teaches filling without injection. Valyi and Nohara teach the use of a core supporting sidewalls of the container during pressure molding. All of these references teach away from the present invention as claimed.

In view of the above, the present claims are patentable over the cited prior art.

Rebuttal of Examiner's Response to Arguments

The Examiner's position that the limitation "a resin body injection over-molded" does not impart any structure over the container of Barriere is not supported with evidence. In fact, the Examiner fails to state precisely how the articles are the same. Applicants' earlier response clearly indicated why the invention as recited is structurally different, i.e., different molecular level structure imparted by injection molding. The Examiner failed to contradict Applicant's position that the molecular level structure is different. Accordingly, Applicants presume that the Examiner is conceding that Applicants' position with respect to molecular level structure is correct. If the Examiner is conceding that the molecular level structure is different, then the Examiner's

position that the limitation does not impart structure over the container of Barriere is incorrect and should be reversed.

Applicants' earlier response also pointed out that one skilled in the art of molding would recognize the recitation of injection molding as a structural difference. The Examiner has failed to rebut this argument.

If the Examiner has any evidence or information indicating that the caste resin body as taught by Barriere has the same molecular level structure as the injection molded resin body claimed by the present application, it would be gratefully appreciated if the Examiner could provide the evidence or information to Applicants.

The present claims distinguish structurally over the cited prior art references. None of the cited prior art references teach or suggest a resin body made from a thermoplastic resin injection over-molded onto a bottle.

Also, as noted in Applicants' earlier response, by granting patent claims with recitations that appear to be product-by-process, but are actually structural differences, the U.S. Patent Office has recognized such distinctions. See for example, Wallace 3,007,594 and Nohara 4,546,925, describing what at first glance could be construed as identical products. Nohara, issued almost 30 years after Wallace, includes as a recitation "...portions are integrally formed of a thermoplastic polyester...". While this appears to be product-by-process language, it is more clearly understood by those skilled in the art as structurally distinguishing the component from non-integrally formed components.

In view of the amendments and remarks above, it is respectfully submitted that the present invention is patentable over the cited prior art. Early and favorable consideration is respectfully requested. Applicants reserve the right to file division, continuation and continuation-in-part applications to prosecute any inventions or species.

Submitted concurrently herewith is an Information Disclosure Statement citing a single reference, U.S. Pat. No. 4,078,508 to Schertenleib, the counterpart to GB1468953 which was cited as an "X" reference in a search report dated 14 July 2004 issued by the European Patent Office in a counterpart to the present application.


Submitted concurrently herewith is a Petition for Extension of Time to extend the time to respond by three months from January 19, 2005 to April 19, 2005. The Petition includes authorization for the Commissioner to charge the fee for extension to Deposit Account No. 05-1320.

If there are any other issues remaining which the Examiner believes could be resolved through telephone contact, the Examiner is respectfully encouraged to call the undersigned at the telephone number indicated below.

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